

disconnectably connecting the second sleeve in the open-end of the fixedly pivotably connected sleeve, said second sleeve being formed with an open-end for operably receiving an interchangeable tool bit member.

100. The multi-functional hand tool of claim 98, said wing member edge having a cross dimension less than the tubular body and extends from the closed end to the tubular body.

101. The multi-functional hand tool of claim 92, said handles being asymmetrical.

REMARKS

Applicants successfully prosecuted companion case U.S. Serial No. 09/237,557, now Patent No. 6,257,106 (the "companion case"). The companion case and the present application claim closely related constructions with one difference, namely the pliers/handle configuration, which difference is not relevant to the commonly claimed patentable subject matter. The patented companion tool has a double pivot pliers/symmetrical handle configuration, whereas the presently tool claimed has asymmetrical handles/ single pivot configuration.

Present claim 92 tracks the patentable subject matter of claim 11 in the companion case, U.S. 6,257,106. An element-by-element of the respective claims follows.

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| U.S. Serial No. 09/901,305 Claim 92 | U.S. 6,257,106 Claim 11 |
| A multi-functional hand tool comprising: at least one interchangeable tool bit member, opposed pliers jaws, first and second elongated handles having oppositely disposed first and second ends, said pliers jaws being operably disposed at said first ends, said first handle having opposed sides forming an elongated cavity, a bladed tool, and means for pivotably connecting the bladed tool to the first handle adjacent the first handle second end, a sleeve comprising a one-piece unitary construction formed with a tubular body having a closed-end and an open end, said open end being formed for removably operably holding said tool bit member, said tool bit member being disposed in said sleeve open end, means for pivotably fixedly connecting the sleeve adjacent closed end to the first handle adjacent the first handle second end so that the sleeve is non-removable, whereby the sleeve and the tool bit member are pivoted from an operable position disposed away from the first handle to an inoperable position disposed in the first handle cavity so that the sleeve and tool bit are inoperably stowed in the first handle without having to remove and separately stow the tool bit member or sleeve outside the pliers first handle cavity thereby permitting ready alternate pliers or tool bit drive use. | A multi-functional hand tool comprising, pliers jaws, elongated handle having oppositely disposed first and second ends, and each handle having opposed sides, and means for pivotally connecting the pliers jaws to the handles adjacent the first ends so that the handles open and close the pliers in a pliers operable position and hold the pliers closed in a pliers inoperable position, said means for pivotally connecting said pliers jaws comprising spacedly disposed pivot axes said handles being in about parallel disposition in said pliers inoperable position, interchangeable tool bits, sleeve means for removably holding said tool bits, said sleeve means being formed with a closed end and an open end, said open end being formed to slide receive said tool bits, and means for pivotably connecting the sleeve means closed end to one handle second end so that the sleeve means is pivotable from an inoperable position between the one handle sides, said sleeve means being non-removably connected to said means for pivotally connecting the closed end, said other handle comprising a plurality of bladed tools, and means for pivotally connecting said bladed tools to said other handle second end. |

The prior art cited and relied on in the prosecution of U.S. 6,257,106 and in the present application are substantially equivalent. Specifically, (now cited) Harrison et al. and (previously cited) Chachot are companion Swiss Army patents that disclose the same removable double open-ended sleeve construction, with Harrison et al. being the double pivot/symmetrical handle variant and Cachot being the single pivot/asymmetrical handle variant. Applicants successfully argued that, like Harrison et al., Cachot "discloses a necessarily removable sleeve" and "directs one away from a

fixedly connected sleeve". Applicants also successfully argued that the Record had established that Cachot teaches a removable or disconnectable sleeve and away from the present invention. Indeed, the same Examiner of record herein, in a related Divisional Application, Serial No. 09/237,565, relied on Cachot to meet the limitation of a disconnectable sleeve. The cognizable pliers multi-tool art Harrison et al. and Cachot consistently teach a double open-ended disconnectable sleeve, and consequently teach away from a closed-ended fixedly pivotably connected sleeve. The prevailing arguments in the companion patent are applicable to and conclusive in the present application. Present claim 92 tracks and is more specific than claim 11 of Patent No. 6,257,106, and a fortiori allowable. Applicants further submit that the rules mandate consistency in the prosecution records of companion cases. Claim 92 claims essentially the same patentable subject matter but in more specific terms with essentially the same cited prior art being relied on. Claim 92 is therefore allowable.

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The present invention, as variously stated in the specification, relates to a pliers multifunctional hand/survival tool having interchangeable tool bits. The closest prior art is admittedly Harrison et al. (or Cachot). Harrison et al. directs the practitioner to a necessarily removable and separately stowable sleeve and to separately stowable interchangeable tool bits. The prior art interchangeable tool bits and sleeve are removed

and stored in a separate pouch. This disconnect, removal and storage is required before the pliers is operable. Cachot confirms this direction of the pliers multifunctional interchangeable tool bit hand tool art. The pliers multifunctional hand/survival tool art Harrison et al. and Cachot teach away from the present invention in this principal respect.

The October 8, 2002 Office Action ("Office Action") mischaracterizes the Harrison et al. disclosure and apparently disregards the Harrison et al. clear teaching away from the present invention. It is alleged that Harrison et al. "discloses all of the claim subject matter except for having a closed end of the sleeve non removably connected to the means for pivotably connecting the sleeve and being pivotable to an operable position between the handle sides". At the outset, Harrison et al. does not disclose all but a sleeve having a closed end, but rather importantly discloses a sleeve with necessarily oppositely disposed open ends. A closed-ended sleeve renders Harrison et al. inoperable. Harrison et al. militates against reconstruction to a closed-ended sleeve. The Office Action then, in hindsight, and in disregard of the clear direction of Harrison et al., combines prior art constructions that do not merely, as alleged, supplement that which is missing in Harrison et al., but necessarily require a deconstruct of Harrison et al. There is no motivation in the art to combine the references, deconstruct Harrison et al. and disregard the teaching away construction of Harrison et al. The Office Action combines

Harrison et al. with Izhak, Beran, or Liu. These combinations are deficient and teach away from the present construction in several principal respects.

Beran does not disclose a sleeve which is suitable for or contemplates an interchangeable tool bit. Each of the so-called Beran sleeves is in fact a thin sheet metal "sheath" which is "flat or is substantially the same thickness as the [blade] shank" (col. 3, lines 20-21). The Beran thin flat sheath construction is inoperable for transmitting torque to a tool bit. Beran teaches away from tool bit functionality. A tubular sleeve member is inconsistent with Beran. Beran also teaches away from interchangeability. The three Beran sheaths are differently numbered in the Figures and differently configured to receive respective differently configured blades. Beran also teaches away from in-pivot cavity storage of interchangeable bits. Beran, at col.1, lines 60-64 teaches "a [separate] case or box designed to contain additional blade elements for replacing other blades which may have become dull or broken". Beran teaches worn blade separate storage for wear replacement, and in doing so, teaches away from interchangeable functionality and away from in-sleeve in-pivot cavity storage. Beran, like Harrison et al., teaches outside the pivot sleeve/sheath cavity storage of tool bits/blade shanks. Beran and Harrison et al. teach away from each other and away from the present invention in several principal respects. Beran and Harrison et al. are not combinable to

make out a showing of obviousness for each and all of the foregoing reasons.

Liu confirms the direction of Harrison et al., Cachot and Beran to stow tool bits in a separate compartment and not in a sleeve in a handle pivot sleeve receiving cavity. Both Liu and Harrison et al. similarly teach away from this important aspect of the invention. Further, Liu requires removable separable sides and cover 24 to first be assembled in-place in order for the user to grip the drive bit tool. This Liu teaching to separable-to-be-assemble sides and cover for operable grip militates against combining Liu with the fixed sided pliers handle construction of Harrison et al. The Liu and Harrison et al. references may not be combined, absent a good dose of reconstruction and hindsight. Further, insofar as both Liu and Harrison et al. teach separate out-of-sleeve tool bit storage and non-pivot cavity storage, the alleged combination is fatally deficient.

Izhak teaches away from interchangeable tool bit functionality and sleeve non-removability. Izhak, in Figures 4a – 4d, discloses that each extending member is specifically machined, sized and configured to slidably engage a specific corresponding holder aperture. This is a clear teaching away from interchangeable functionality. Izhak discloses slidably separable housing sides (FIG.3) for removal of the keys and sleeves. Izhak and Harrison et al. both teach removable sleeves and away from a fixedly pivotably connective sleeve of the present invention.

Izhak provides a housing and shaft which are readily slidably disassembled (FIG. 3) so that any desired key/sleeve may be removed so that the removed key may then be used to unlock a door in the customary manner. Izhak, in this basic respect, teaches away from a fixedly connected pivot shaft. Izhak key removability function is consistent with the Izhak key ring/key case analogy variously stated in the background section of the Izhak specification. Insofar as both Harrison et al. and Izhak disclose constructions with slidably removable non-fixedly connected sleeves, combining these disclosures cannot make out a prima facie showing of the presently claimed fixedly connected pivotable sleeve construction.

Izhak, on fair reading, is far removed from a pliers multifunctional interchangeable hand/survival. Izhak, as the Izhak specification variously states, is a key organizer.

The variously combined references teach away from each other in several important respects. Where one reference teaches away from another reference, which references are combined in an obviousness assertion, this fact "alone can defeat [the] obviousness claim". Winner International Royalty Corporation v. Wang, cert. den., 202 F.3d 1340, at 1350, 53 U.S.P.Q. 1580 (Fed.Cir. 2000).

Harrison et al., Izhak, Beran and/or Liu also teach away from:

"said tool bit being disposed in said sleeve open end, means for pivotably fixedly connecting the sleeve adjacent closed end to the first handle adjacent the first handle second end so that the sleeve is non-removable, whereby the sleeve and the tool bit are pivoted from an operable position disposed away from the first handle to an inoperable position disposed in the first handle cavity so that the sleeve and tool bit are inoperably stowed in the first handle without having to remove and separately stow the tool bit or sleeve outside the pliers first handle cavity thereby permitting ready alternate pliers or tool bit drive use." (Claim 92).

Cachot and Harrison et al. are companion Swiss Army constructions. Indeed, Cachot discloses a pliers/handle configuration that more closely resembles the present a pliers/handle configuration than Harrison et al.

Claims 95-96 define the sleeve construction in more specific terms to further distinguish the present construction over Harrison et al., Cachot, Beran, Liu and/or Izhak.

Claim 97 further defines the invention as to the readily pivotably stowable double-ended tool bit, so as to render the pliers immediately readily operable. Harrison et al., Cachot, Beran, Liu and/or Izhak disclose construction which consistently teach first separate storage and away from this aspect of the invention.

Claims 98-100 claim the novel wing member extending outwardly from and between closed end and tubular sleeve body. This tubular sleeve/wing member construction is far removed from the prior art.

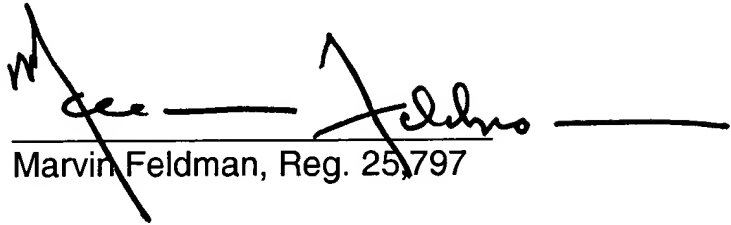
Claim 99 is directed to a second sleeve disconnectably connected to the first sleeve for operably positioning a tool bit. This feature is the gravamen of the patentable subject matter of several related patents issued to the applicants by the Examiner of Record. Again, applicants respectfully submit that there be consistency in the prosecution records of companion cases claiming essentially the same subject matter.

The present invention (e.g. claim 92) reduces the number of elements (viz. the Harrison et al./Cachot sleeve and tool bit storage pouch) while improving function (viz. ready alternate drive bit, bladed tool and pliers use). There is a well established case law principle that the elimination of elements with improved function defines a patentable invention.

An early allowance is respectfully requested.

Respectfully submitted,

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